

**REMARKS/ARGUMENTS**

Claims 1-6, 8-10 and 24-31 remain in this application. Claims 7 and 11-23 have been canceled.

In the decision by the Board of Patent Appeals and Interferences, the Board affirmed the previous rejection of the claims because the Cohen patent, over which the claims were rejected, does not state that there is a tight fit between the holes and the implant shafts, and, as a result, “even a slight degree of slidable motion would satisfy the claim”. (Decision, page 6, lines 10-12).

Independent claim 1 has been amended and now recites that “the implant initially keeps said exposed cancellous bone surface spaced apart ... while permitting unrestricted relative slidable motion between the face and the cancellous bone surface”, as well as further reciting “using the joint while ... causing unrestricted slidable motions between the face ....” Claim 8 is identically limited.

Independent claim 24 recites “that the implant can slidably move without restriction relative to the at least one degenerated cancellous bone surface, allowing the face to slidably move relative to the at least one degenerated cancellous bone surface without restriction ....”

Independent claim 25 recites amongst others “permitting unrestricted relative slidable motion between the face and the exposed cancellous bone surface; using the joint while ... slidably moving the face relative to the exposed cancellous bone surface without restriction caused by the implant ....”

Finally, independent claim 26 recites that “the face is freely slidably movable relative to the cancellous bone surface ... [and] slidably moving the face relative to the cancellous bone surface without restriction caused by the implant ....”

In its decision of September 26, 2003, the Board determined that “in the absence of a tight fit between holes and implant shafts, at least some degree of slidable motion between

the face (i.e., sphere 72) of patentee's Figure 10 implant and the cancellous bone surface would be possible." (Decision, page 6, lines 7-10, emphasis added).

All independent claims now affirmatively recite that there is unrestricted movement between the opposing surfaces of the implant and the bone. Cohen's shafts extending into holes in the bone at most permit some degree of slidable motion, as noted in the Board's decision, but clearly prevent unrestricted motion. There is also no suggestion in Cohen, or elsewhere in the prior art, to permit such unrestricted movements between opposing implant and bone surfaces.

Accordingly, independent claims 1, 8 and 24-26 are neither anticipated by nor obvious over Cohen.

Applicant has also noted the comment in the Board's decision whether or not the application as originally filed is enabling with respect to claim 8, which permits slidable motions between both faces of the implant and opposing resected surfaces of the bones. While the drawing figures of this application show an implant which has a stem on one side and an unobstructed face on the other side, the specification clearly discloses that both faces of the implant can be slidable relative to the bone when this is deemed desirable.

In addition, claim 8 as originally filed with the application is part of the disclosure and recites treating a joint with first and second mating joint surfaces by removing at least a portion of the two joint surfaces to expose first and second cancellous bone surfaces, selecting an implant with first and second implant surfaces that correspond to the two cancellous bone surfaces, and placing the two implant surfaces between and against the two exposed bone surfaces. Claim 8, as originally filed, further recites that "the cancellous bone surfaces initially form fibroblast which progress into fibrocartilage at each said bone surface as the implant is resorbed ...."

From this alone, one of ordinary skill in the art readily understands that stemless implants are to be used because otherwise, i.e. if one implant surface had a stem, both implant

faces could not engage and rub against the two opposing surfaces of the bones to generate fibrocartilage at each bone surface.

Further, in the paragraph bridging pages 10 and 11 of the application as initially filed, applicant states:

The preferred embodiment uses an implant having a stem to secure the implant to the joint. In some cases a central stem may not be necessary.

Thus, the application, as originally filed, teaches one of ordinary skill in the art how to practice the method recited in claim 8 and, therefore, the application as originally filed is enabling.

In view of the foregoing, applicant submits that independent claims 1, 8 and 24-26, and therewith all claims depending from the independent claims, are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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